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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,136	09/30/2003	Katie Kuwata	66329/31246	5723
23380 7590 01/14/2008 TUCKER ELLIS & WEST LLP 1150 HUNTINGTON BUILDING 925 EUCLID AVENUE CLEVELAND, OH 44115-1414			EXAMINER ROBINSON, MYLES D	
			ART UNIT 2625	PAPER NUMBER
			NOTIFICATION DATE 01/14/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	Application No. 10/675,136	Applicant(s) KUWATA ET AL.	
	Examiner Myles D. Robinson	Art Unit 2625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 - 32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/30/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The examiner has considered the references listed in the Information Disclosure Statement (IDS) submitted on 9/30/2003 (see attached PTO-1449).

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference character 200 (*see Specification [page 3, line 24]*). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

3. The following quotation of 37 CFR 1.75(a) is the basis of the objection:
  - (a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

4. **Claims 4 – 9, 13 – 18, 22 – 25 and 29 – 32** are objected to under 37 CFR 1.75(a) as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention or discovery.

**Claims 4, 13, 22 and 29** recite the limitation “a font request” in line 2 of these claims after the limitation “a font request” was claimed in line 6 of the respective parent claims 1, 10, 19 and 26. The applicant has failed to particularly point out and distinctly claim if the applicant is referring to ***the same, instant*** “font request” or ***a unique and distinctly different*** “font request” within the claim. All claims dependent upon this claim suffer the same deficiency and, therefore, are objected to as well.

5. **Claims 4, 13, 22 and 29** recite the limitation “at least one networked workstation” in line 2 of these claims after the limitation “at least one networked workstation” was claimed in line 6 of the respective parent claims 1, 10, 19 and 26. The applicant has failed to particularly point out and distinctly claim if the applicant is referring to ***the same, instant*** “networked workstation” or ***a unique and distinctly different*** “networked workstation” within the claim. All claims dependent upon this claim suffer the same deficiency and, therefore, are objected to as well.

6. **Claims 4, 13, 22 and 29** recite the limitation “a prompt” in line 4 of these claims after the limitation “prompting an associated user” was claimed in line 3 of these claims. The applicant has failed to particularly point out and distinctly claim if the applicant is referring to ***the same, instant*** “prompt” or ***a unique and distinctly different*** “prompt”

Art Unit: 2625

within the claim. All claims dependent upon this claim suffer the same deficiency and, therefore, are objected to as well.

7. **Claims 4, 13, 22 and 29** recite the limitation "a font" in line 5 of both claims after the limitation "a font" was claimed in line 3 of these claims. The applicant has failed to particularly point out and distinctly claim if the applicant is referring to ***the same, instant*** "font" or ***a unique and distinctly different*** "font" within the claim. All claims dependent upon this claim suffer the same deficiency and, therefore, are objected to as well.

8. **Claims 4, 13, 22 and 29** recite the limitation "a user" in line 4 of both claims after the limitation "an associated user" was claimed in line 3 of these claims. The applicant has failed to particularly point out and distinctly claim if the applicant is referring to ***the same, instant*** "user" or ***a unique and distinctly different*** "user" within the claim. All claims dependent upon this claim suffer the same deficiency and, therefore, are objected to as well.

9. **Claims 5, 14, 23 and 30** recite the limitation "an associated user" in line 2 of these claims after the limitations "an associated user" (line 3) and "a user" (line 4) were claimed in the respective parent claims 4, 13, 22 and 29. The applicant has failed to particularly point out and distinctly claim if the applicant is referring to ***the same, instant*** "user" or ***a unique and distinctly different*** "user" within the claim. All claims

dependent upon this claim suffer the same deficiency and, therefore, are objected to as well.

10. **Claims 5, 14, 23 and 30** recite the limitation "a font" in line 2 of these claims after the limitation "a font" was claimed in lines 3 and 5 of the respective parent claims 4, 13 23 and 30. The applicant has failed to particularly point out and distinctly claim if the applicant is referring to ***the same, instant*** "font" or ***a unique and distinctly different*** "font" within the claim. All claims dependent upon this claim suffer the same deficiency and, therefore, are objected to as well.

11. **Claims 8, 17, 24 and 31** recite the limitation "a font request" in line 2 of these claims after the limitation "a font request" was claimed in line 6 of the respective parent claims 1, 10, 19 and 26. The applicant has failed to particularly point out and distinctly claim if the applicant is referring to ***the same, instant*** "font request" or ***a unique and distinctly different*** "font request" within the claim. All claims dependent upon this claim suffer the same deficiency and, therefore, are objected to as well.

12. **Claims 8, 17, 24 and 31** recite the limitation "at least one networked workstation" in line 3 of these claims after the limitation "at least one networked workstation" was claimed in line 6 of the respective parent claims 1, 10, 19 and 26. The applicant has failed to particularly point out and distinctly claim if the applicant is referring to ***the same, instant*** "networked workstation" or ***a unique and distinctly different***

“networked workstation” within the claim. All claims dependent upon this claim suffer the same deficiency and, therefore, are objected to as well.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

13. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

14. **Claims 1 – 32** are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

**Claims 1 – 32** are drawn to **practical applications** that DO NOT produce a useful, concrete and tangible result.

In determining whether the claim is for a “practical application,” the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the **final result achieved by the claimed invention** is “useful, tangible and concrete.” AT&T, 172 F.3d at 1358, 50 USPQ2d at 1451.

The tangible requirement does not necessarily mean that a claim must be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that **the process claim must set forth a practical application of that §101 judicial exception to produce a real-world result.** Benson, 409 U.S. at 71-72, 175 USPQ at 676-77. See MPEP 2106.IV.C.2 (2)(b).

15. **Claims 19 – 32** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 19 and 26 are drawn to a computer implemented process that merely manipulates data or an abstract idea, or merely solves a mathematical problem without a limitation to a practical application in the technological arts.

In order for a claimed invention to accomplish a practical application, it must produce a “useful, concrete and tangible result” *State Street*, 149 F.3d at 133, 47 USPQ2d at 1601-02 (see MPEP 2106.II.A). A practical application can be achieved through recitation of “a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan”, or “limited to a practical application within the technological arts” (MPEP 2106IVB2(b)). Currently, claim \*\*\* meets neither of these criteria. In order for the claimed process to produce a “useful, concrete and tangible result”, recitation of one or more of the following elements is suggested:

- The manipulation of data that represents a physical object or activity transformed from outside the computer (MPEP 2106 IVB2(b)(i)).
- A recitation of a physical transformations outside the computer, for example in the form of pre or post computer processing activity (MPEP 2106 IVB2(b)(i)).
- A direct recitation of a practical application in the technological arts (MPEP 2106 IVB2(b)(ii)).



16. **Claims 19 – 32** are drawn to a claimed invention which preempts an abstract idea of a computer-implemented method and computer-readable medium for a system.

Even when a claim applies to a mathematical formula, for example, as part of a seemingly patentable process, however, one must ensure that it does not in reality “seek[] patent protection for that formula in the abstract.” Diehr, 450 U.S. at 191, 209 USPQ at 10. **One may not patent a process that comprises every “substantial practical application” of an abstract idea** (e.g. computer-readable medium, computer-implemented method), because such a patent “in practical effect would be a patent on the [abstract idea] itself.” Benson, 409 U.S. at 71-72, 175 USPQ at 676; cf. Diehr, 450 U.S. at 187, 209 USPQ at 8 (stressing that the patent applicants in that case did “not seek to pre-empt the use of [an] equation,” but instead sought only to “foreclose from others the use of that equation in conjunction with all of the other steps in their claimed process”). Such limitations on process patents are important because without them, “a component draftsman [could] evade the recognized limitations on the type of subject matter eligible for patent protection.” Diehr, 450 U.S. at 192, 209 USPQ at 10, accord Flook, 437 U.S. at 590, 198 USPQ at 197. Thus, a claim that recites a computer that solely calculates a mathematical formula (see Benson), a computer disk that solely stores a mathematical formula, or an electromagnetic carrier signal that carries solely a mathematical formula is not statutory. See MPEP 2106.IV.C.3.

To claim solely a computer-readable medium without claiming its relationship with a computer which executes the computer program stored within said computer-readable medium, is an attempt to patent those computer-readable media that will never

Art Unit: 2625

connect with, communicate with, exchange computer data with, or transmit electrical signals back and forth with at least one computing device wherein the utility of the computer-readable medium is never fully realized unless such connection, communication, exchange, transmission or other computer-related interaction is executed. The intended use of the claimed invention is "for a networked font rendering system". However, the Examiner contests that this intended use will never be fully realized unless such connection, communication, exchange, transmission or other computer-related interaction is actually executed by a computing device.

To solely claim a computer-implemented method without claiming that said method is stored on a computer-readable medium and said method is executed by a computer reading the computer program from said medium, is an attempt to patent those computer-implemented methods which are performed solely by a computer executing a computer program (e.g. full automation) and those computer-implemented methods which are preformed by a person utilizing a computer to implement the method (e.g. user interactivity) wherein the claim as written encompasses every substantial practical application of this abstract idea.

17. **Claims 19 – 32** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 19 and 26 are drawn to non-functional descriptive material. MPEP 2016.IV.B.1(a) (Nonfunctional Descriptive Material) states:

"Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101."

"Where certain types of descriptive material, such as music, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing process performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer."

"For example, music is commonly sold to consumers in the form of a compact disc. In such cases, the know compact disc acts as nothing more than a carrier for nonfunctional descriptive material. The purely nonfunctional descriptive material cannot alone provide the practical application for the manufacture."

**MPEP 2106.IV.B.1 (Nonstatutory Subject Matter) states:**

"When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement."

**Claims 19 and 26** currently recite a computer-readable medium and a computer-implemented method, respectively. There is no functional relationship imparted upon the computer-readable medium by a computing device of claim 19, and conversely, there is no functional relationship imparted to the computer-implemented method without a computing device executing a computer program stored on a computer-readable medium of claim 26. Therefore, the claim is drawn to non-functional descriptive material which is non-statutory per se. The fact that the claim recites a computer readable medium does not provide utility (i.e., practical application in the technological arts) required under 35 U.S.C. §101 for the manufacture.

All claims dependent upon these claims suffer the same deficiencies and, therefore, are rejected as well.

### ***Claim Rejections - 35 USC § 102***

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2625

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

19. **Claims 1 – 32** are rejected under 35 U.S.C. 102(b) as being anticipated by **Flowers, Jr. et al.** (U.S. Patent No. 5,533,174).

Referring to **claim 1**, Flowers discloses a networked font rendering system (see *Figs. 1 – 2, network bus 22 [column 2, lines 52 – 61]*) comprising:

means adapted for acquiring vector data (*see Figs. 1 – 2 wherein FAF font server 16 retrieves the appropriate fonts from font storage 18 [column 4, lines 22 – 36] and see Fig. 3A wherein FAF font server 16 retrieves bitmap or outline formats which are printer specific in step 40 [column 4, lines 50 – 62]*) representative of a vector based font (*column 2, lines 32 – 42 wherein the outline formats of characters are analogous to vector based fonts*),

rendering means adapted for rendering (*see Figs. 1 – 2 wherein FAF font server 16 renders outline and/or bitmap fonts*) at least a portion of the vector based font to generate font images corresponding thereto (*see Fig. 3B, steps 56 – 62 [column 4, lines 22 – 36 and column 6, lines 6 – 17]*),

font storage means (*see Figs. 1 – 2, font storage 18*) adapted for storing the font images on a networked memory (*column 1, lines 36 – 41, column 2, lines 52 – 61 and column 4, lines 22 – 36*),

means adapted for receiving a font request (*see Fig. 4, steps 74 – 75 [column 1, lines 46 – 51, column 3, lines 17 – 31, column 7, lines 57 – 62 and column 8, line 54 –*

*column 9, line 12]) from at least one networked workstation (see Figs. 1 – 2, workstation 12 [column 4, lines 9 – 21]), and*

*communication means (see Fig. 1, network bus 22 and see Fig. 2 wherein workstations 12 and printers 14 comprise FAF communication 30 and are interconnected as well as additionally connected to FAF font server 16 via logical connections 31, 33, 35) adapted for selectively communicating the font images to generate document print data in accordance with a request from the at least one networked workstation (column 1, lines 36 – 41, column 2, lines 52 – 61 and column 4, lines 9 – 47).*

Referring to **claim 2**, Flowers discloses the system further wherein the communication means includes means adapted for communicating the font images to the at least one networked workstation (see Fig. 2 wherein logical connections 31 and 33 are double-headed arrows which inherently disclose bi-directional communication and see column 3, lines 17 – 31 wherein available font images are communicated back to the user at workstation 12).

Referring to **claim 3**, Flowers discloses the system further wherein the communication means includes means adapted for communicating the font images to an associated printing device (see Figs. 1 – 2 wherein printers 14 have access to fonts available either directly over a connection to a font storage device or over a network and uses font information to produce character maps for printed copy [column 1, lines 31 – 40 and column 4, lines 9 – 21]).

Referring to **claim 4**, Flowers discloses the system further wherein the means adapted for receiving a font request from at least one networked workstation includes:

means adapted for prompting an associated user for selection data to select a font;

means adapted for receiving user selection data resultant from a prompt of a user for a font; and

means adapted for requesting the font in accordance with the user selection data (see Fig. 4, steps 74 – 75 [column 1, lines 46 – 51, column 3, lines 17 – 31, column 7, lines 57 – 62 and column 8, line 54 – column 9, line 12]).

Referring to **claim 5**, Flowers discloses the system further wherein the means adapted for prompting an associated user for selection data to select a font includes means adapted for displaying selected information about each font which is available for selection (see Fig. 4, steps 74 – 75 [column 1, lines 46 – 51, column 3, lines 17 – 31, column 7, lines 57 – 62 and column 8, line 54 – column 9, line 12]).

Referring to **claim 6**, Flowers discloses the system further wherein the means adapted for displaying selected information about each font includes at least one of font type, font size, and font style for each font (column 1, lines 25 – 30).

Referring to **claim 7**, Flowers discloses the system further wherein the selection data includes at least one of font type, font size, font style, tab information, location of font within document, and font format (column 1, lines 25 – 30).

Referring to **claim 8**, Flowers discloses the system further comprising updating means adapted for updating font storage means for selected font information received

in a font request from at least one networked workstation (*column 3, lines 40 – 42 and column 10, lines 52 – 55*).

Referring to **claim 9**, Flowers discloses the system further comprising means adapted for deleting selected font information from the font storage means upon at least one of a predetermined time interval in which the font has not been requested (*see Fig. 3A, steps 44 – 46 wherein an electronic license for a specific font is valid for a predetermined amount of time such that if the license expires (e.g. the license is no longer current), then the user is denied access to that specific font [column 2, lines 62 – 64, column 5, lines 17 – 23 and column 8, lines 40 – 42]*) and a request received from an associated user (*column 10, lines 52 – 55*).

Referring to **claims 10 – 18**, the rationale provided in the rejection of claims 1 – 9, respectively, are incorporated herein. In addition, the systems of claims 1 – 9 perform the methods of claims 10 – 18, respectively.

Referring to **claims 19 – 32**, respectively, the rationale provided in rejections of claims 1 – 5, 8 and 9, respectively, are incorporated herein. The methods of claims 1 – 5, 8 and 9 are stored as a program of instructions of claims 19 – 25, respectively, within memory and executed by a series of processors (*see Figs. 1 – 2, FAF font server 16, workstations 12, printers 14 [column 4, lines 9 – 36]*) and include the limitations and elements of the computer-implemented methods of claims 26 – 32, respectively.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Myles D. Robinson whose telephone number is (571) 272-5944. The examiner can normally be reached on M-F 8:30am-5:00pm.

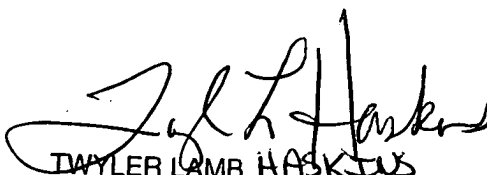
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler L. Haskins can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MDR

1/4/08



TWYLER LAMB HASKINS  
SUPERVISORY PATENT EXAMINER